

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed April 18, 2008. At the time of the Office Action, Claims 1-16 were pending in this Application. Claims 1-16 were rejected. Claims 17 and 33 have been amended. Claims 34-37 have been added. Applicants respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 17-19 and 24-33 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,978,316 issued to Ghaffar et al. ("Ghaffar"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

The Examiner stated that *Ghaffar* discloses the invention as claimed. To this end, the examiner stated that *Ghaffar* teaches "inserting, in the resulting profile information, a first item of profile information which specifies which type of the user data objects may be processed by the terminal (350, fig. 3; col. 51 – col. 6, line 2)". (Office Action, paragraph 7) Applicant respectfully disagrees.

Ghaffar states:

The transcoder 230 filters the baseline representation of the message to remove information that cannot be processed effectively by the mobile terminal 100 (step 370), thereby providing a filtered baseline representation that lies within the messaging capability of the mobile terminal 100. For example, the message may be an email message with an image and a word processor document attached. If the profile identifies the mobile terminal 100 as a cellular telephone having SMS capability, the transcoder 230 may provide a filtered baseline representation that contains the subject line of the email message, identification of the originator of the message, and names of the two attachments. On the other hand, if the profile identifies the mobile terminal 100 as a personal digital assistant with more advanced messaging capability but a relatively small monochromatic display, the transcoder 230 may provide a filtered baseline representation that includes the full email text, the full word processor document, and a scaled-down representation of the image. The transcoder 230 returns the filtered baseline representation to the message processor 210, which forwards the filtered baseline representation to the message server 200 (step 380).

(*Ghaffar*, col. 5, lines 51 – col. 6, line 5) This paragraph states nothing about an additional item inserted into a resulting profile as claimed. It merely describes that an additional transcoder is present which is capable of filtering the baseline representation of the message in a way that it adapts to the capabilities of the mobile terminal. However, the above cited claim limitation requires that an item of profile information is inserted into the resulting profile that indicates what type of information can be processed by the terminal. Applicant amended independent claim 17 to state that the item of profile information indicates which type of data can be processed directly by the terminal. This limitation is disclosed in the original submitted specification, for example, on page 8, paragraph [0013]. Hence, no new matter has been introduced.

Ghaffar discloses a system in which the profile exclusively includes information about the terminal. To this end *Ghaffar* states:

The profile includes information about the messaging capability of the mobile terminal 100. For example, the profile may specify whether the mobile terminal 100 employs SMS, EMS, or MMS formats and protocols, whether the mobile terminal 100 has a color or monochromatic display, the size or size category of the display, and so forth. The profile is received by the message server 200, which passes the profile to the message processor 210 (step 300).

In turn, the message processor 210 stores the profile in the database 220 for future reference (step 310).

When the messaging system subsequently receives a message addressed to the mobile terminal 100 (step 320), for example a message from the fixed terminal 110, the message server 200 converts the message to a baseline representation of the message (step 330). For example, the message server 200 may convert the message into a specified XML format through a simple custom-coded software extension. The message server 200 then passes the baseline representation to the message processor 210.

(*Ghaffar*, col. 5, lines 24-42) Thus, the message processor 210 receives only data of the capabilities of the terminal proper. If the message processor 210 receives a message that cannot be processed by the terminal the message processor forwards this message to transcoder 230. (*Ghaffar*, col. 5, lines 42-63)

However, the present independent claims as amended are directed to a different kind of system in which a message is sent to a terminal via a connection component, wherein both the terminal and the connection component have capabilities of processing the data. The resulting profile includes both capabilities but does not distinguish between the two. According to the independent claims, an additional item of profile information is included in the resulting profile to indicate which type of data can be processed directly by the terminal. Thus, a system that sends data to a terminal can pre-filter its content to most efficiently send data to the terminal without requiring the connection component to process the data first.

None of the cited art discloses these limitations. Hence, Applicant believes that the present independent claims are patentable in view of the prior art. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102 or §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

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PATENT APPLICATION
10/525,607

Association of Customer Number and Change of Correspondence Address

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to Andreas Grubert at 512.322.2545. A Revocation and Power of Attorney will be submitted shortly.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants respectfully submit a Petition for One-Month Extension of Time. The Commissioner is authorized to charge the \$120.00 Extension fee, and \$50.00 for 1 (one) claim in excess of 20, to Deposit Account 50-2148 in order to effectuate this filing.

Applicants believe there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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Date: August 18, 2008

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